REMARKS / ARGUMENTS

A. REJECTIONS UNDER 35 U.S.C. 102

On page 2 of the Office Action, the Examiner has rejected claims 29, 31-34, 37, 39-42 and 44-47 under 35 U.S.C. 102(e) as being anticipated by Torikai (US Patent 6,763,396, hereinafter "Torikai"). The Applicant respectfully disagrees as set forth herein below, and submits that claims 29, 31-34, 37, 39-42 and 44-47 are in condition for allowance.

Claim 29

For ease of reference, the Examiner's attention is directed to the following excerpt of claim 29:

> 29. A server for connection to a client via a network [...], said server comprising:
>   * * * * *
> - a processor [...] operable to remotely host execution of an application for [a] client; [...] said processor further operable to generate a universal printer file from said application based on a request for a file to be printed that is embedded in [...] user-input; [...]

The Applicant submits that there is nothing in Torikai that teaches or suggests the aforementioned features of claim 29.

Torikai's invention relates to an apparatus and a method by which a network-connected device such as a printer can be operated to initiate downloading and updating of basic control information such as printer drivers, printing font and the like (*see* Torikai col. 1, lines 19-23). Specifically, Torikai discloses a server **17**, such as an FTP site or a Web site, which maintains "current printer utilities", such as a "printer driver", "firmware" or "printing plotting control firmware" (*see* Torikai items 1, 2 and 3 in Fig. 2, as well as col. 4, lines 3-7 and 46-49). The server **17** is responsive to a "request" received from an networked printer device, to allow such utilities to be downloaded to the network printer device (*see* Torikai col. 7, lines 23-24 and 29-30).

Torikai does not disclose any form of user input, much less any user input that would embed a request for a <u>file to be printed</u>. In fact, the nature of the "requests" discussed in Torikai is limited exclusively to requests for downloadable "utilities" (such as printer drivers and other firmware), which are types of items that are **not** printed. In fact, upon closer inspection, Torikai lacks even a peripheral discussion of how a file would be printed or how a "request for a file to be printed" would be handled.

Furthermore, Torikai is critically devoid of any detailed discussion of the server **17**. All that can be inferred from Torikai is that the server **17** is somehow responsive to a request to cause a printer utility to be downloaded to a requesting entity. Torikai lacks any discussion of an "application" run by the server **17** and, moreover, fails to disclose either an application whose execution is being "remotely host[ed] [...] for [a] client" (*see* instant application, claim 29), or an application from which a "universal printer file" is "generated" "based on a request for a file to be printed that is embedded in [...] user-input" (*see* instant application, claim 29). In the Applicant's respectful view, the Examiner is making unfounded inferences from Torikai, which reference offers nothing more than a cursory functional overview of the server **17**.

In light of the above discussion, it should be apparent that there is at least one feature recited in claim 29 that is neither taught nor suggested by Torikai and, for this reason, the Applicant respectfully requests that the rejection under 35 U.S.C. 102 be withdrawn.

Claims 31-34

Claims 31-34 are dependent either directly or indirectly on claim 29 and therefore include all of the features of claim 29, including the feature(s) already shown to be absent from Torikai. Thus, for the same reasons as those set forth above in support of claim 29, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 31-34.

Claim 37

For ease of reference, the Examiner's attention is directed to the following excerpt of claim 37:

> 37. A client-server computer system comprising:
> * * * * *
> - a client operable to transmit user-input over a network and to receive user-output over said network;
> - a server connected to said client via said network; said server operable to remotely host execution of an application for said client; [...] said server further operable to generate a universal printer file from said application based on a request for a file to be printed that is embedded in said user-input; [...]
> - said client further operable to receive said universal printer file; said client including a universal print file reader operable to interpret said universal print file into a local printer file in cooperation with a local printer driver;
> * * * * *

The Applicant submits that there is nothing in Torikai that teaches or suggests the aforementioned features of claim 37.

Firstly, it is noted that claim 37 contains language similar to that of claim 29 (e.g., a server "operable to remotely host execution of an application for said client", and further "operable to generate a universal printer file from said application based on a request for a file to be printed that is embedded in said user-input"). These features were already shown to be missing from Torikai.

Moreover, claim 37 recites that the client comprises a "universal print file reader", which is "operable to interpret [a] universal print file into a local printer file in cooperation with a local printer driver". There is no such "universal print file reader" disclosed in Torikai, let alone one which "cooperates" with a local printer driver. In fact, Torikai does not even describe a "universal print file", nor does he describe "interpretation" of such a universal print file into a "local printer file". The Examiner's reference to col. 10, lines 34-43 of Torikai does not seem to support his argument to the contrary and, with respect, appears completely irrelevant.

In light of the above discussion, it should be apparent that there is at least one feature recited in claim 37 that is neither taught nor suggested by Torikai and, for this reason, the Applicant respectfully requests that the rejection under 35 U.S.C. 102 be withdrawn.

Claims 39-41

Claims 39-41 are dependent on claim 37 and therefore include all of the features of claim 37, including the feature(s) already shown to be absent from Torikai. Thus, for the same reasons as those set forth above in support of claim 37, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 39-41.

Claim 42

For ease of reference, the Examiner's attention is directed to claim 42 in its entirety:

42. A method of printing comprising:
- receiving a print request at a server from a client remotely connected to said server via a network;
- processing said print request at said server by corresponding said print request to an application hosted on said server on behalf of said client;
- locating a universal printer driver on said client;
- creating a universal printer file from said application using said universal printer driver; and,
- sending said universal printer file over said network.

The Applicant submits that Torikai fails to teach or suggest at least one, if not all, of the aforementioned features of claim 42.

First of all, as previously mentioned, Torikai is devoid of any detailed discussion of the server **17**. It therefore escapes the Applicant how the Examiner could contend that Torikai teaches any of the aforementioned features of claim 42. For example, where in Torikai could the Examiner possibly have found the feature of "processing said print request at said server by <u>corresponding</u> said print request to an application hosted on said server <u>on behalf of said client</u>"? Quite simply, no interpretation of Torikai would permit the Examiner to conclude that this feature is taught by the cited art.

The Examiner is also respectfully directed to the arguments set forth above in support of claims 29 and 37, in which it was made clear that Torikai does not deal with print requests. Rather, Torikai deals exclusively with requests for "utilities" for printers

such as drivers, firmware and the like. Torikai provides no discussion whatsoever of any request for anything to be printed.

In light of the above discussion, it should be apparent that there is at least one feature recited in claim 42 that is neither taught nor suggested by Torikai and, for this reason, the Applicant respectfully requests that the rejection under 35 U.S.C. 102 be withdrawn.

Claims 44-47

Claims 44-47 are dependent either directly or indirectly on claim 42 and therefore include all of the features of claim 42, including the feature(s) already shown to be absent from Torikai. Thus, for the same reasons as those set forth above in support of claim 42, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 44-47.

B. REJECTIONS UNDER 35 U.S.C. 103

On page 4 of the Office Action, the Examiner has rejected claims 30, 35-36, 38, 43 and 48 under 35 U.S.C. 103(a) as being unpatentable over Torikai in view of Meyn *et al.* (US Patent 5,859,623, hereinafter "Meyn"). The Applicant respectfully disagrees as set forth herein below, and submits that claims 30, 35-36, 38, 43 and 48 are in condition for allowance.

Firstly, the Examiner is respectfully reminded that in order to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.). It is the Applicant's respectful submission that the Examiner's argument is defective on all three grounds, which are now dealt with in the following order: (3), (1), (2).

The Prior Art References Do Not Teach Or Suggest All of the Claim Limitations

Meyn discloses an "intelligent display system used for controlling a projector unit, which is used to project computer generated and other images for presentations in meeting rooms" (*see* Meyn col. 1, lines 15-18). Meyn's system "eliminates the need to hook a computer up to a desktop projector" (*see* Meyn col. 10, lines 49-62). Specifically, a computer's floppy drive enables portable document format (PDF) information to be stored on a diskette. The diskette is then used to load the PDF information into Meyn's system for display over a projector (*see* Meyn col. 4, lines 42-50).

It should be apparent that Meyn has nothing to do with the present invention and, moreover, this reference fails to compensate for the defects of Torikai. Specifically, in regard to claim 29 (and therefore claims 30, 35 and 36 by dependency), Meyn fails to teach or suggest:

- a processor [...] operable to remotely host execution of an application for [a] client; [...] said processor further operable to generate a universal printer file from said application based on a request for a file to be printed that is embedded in [...] user-input; [...]

In regard to claim 37 (and therefore claim 38 by dependency), Meyn fails to teach or suggest:

- a client operable to transmit user-input over a network and to receive user-output over said network;
- a server connected to said client via said network; said server operable to remotely host execution of an application for said client; [...] said server further operable to generate a universal printer file from said application based on a request for a file to be printed that is embedded in said user-input; [...]
- said client further operable to receive said universal printer file; said client including a universal print file reader operable to interpret said universal print file into a local printer file in cooperation with a local printer driver;

In regard to claim 42 (and therefore claims 43 and 48 by dependency), Meyn fails to teach or suggest:

- receiving a print request at a server from a client remotely connected to said server via a network;
- processing said print request at said server by corresponding said print request to an application hosted on said server on behalf of said client;

- locating a universal printer driver on said client;
- creating a universal printer file from said application using said universal printer driver; and,
- sending said universal printer file over said network.

Based on the above, it should be apparent that there is at least one feature of each of claims 30, 35-36, 38, 43 and 48 that is not taught or suggested by any of the cited references, and hence the Applicant respectfully requests that the rejection under 35 U.S.C. 103 be withdrawn.

There Is No Suggestion Or Motivation To Modify The References Or To Combine The Reference Teachings

It should be pointed out that Meyn is directed to a presentation arrangement, which comprises an intelligent display system adapted to control a pair of projection display units. The arrangement also includes a personal computer, for storing and executing conventional application software programs for developing presentations (*see* Meyn col. 3, lines 9-30).

Meyn does **not** deal with any form of networked environment whatsoever. In fact, Meyn lacks any description of any form of electronic device that downloads anything from any server anywhere in any network. To the contrary, and due to the very absence of a network, Meyn discloses the use of a diskette to transfer information from the personal computer to the intelligent display system.

Moreover, Meyn is concerned with *displaying* information, not *printing* it; that is to say, any conversion / distillation into PDF is done for the purposes of display, not printing. In fact, Meyn does not describe any printers, and as such, the Examiner's reference to "printing the document at the printer" on page 4 of the Office Action appears to be utterly artificial.

Because Meyn does not deal with printers or networks (let alone a networked printer), it should be apparent that Meyn is **not** "in the same field of endeavor" as Torikai, thus contradicting the Examiner's assertion on page 4 of the Office Action.

Based on the above, it should be apparent that there cannot possibly be any suggestion or motivation to combine the prior art references to arrive at the invention claimed in claims 30, 35-36, 38, 43 and 48, and hence the Applicant respectfully requests that the rejection under 35 U.S.C. 103 be withdrawn.

There Is No Reasonable Expectation of Success

On page 4 of the Office Action, the Examiner contends that "the printer driver in PDF format can be downloaded from the server of Torikai to the computer for updating the necessary of the computer for printing the document at the printer." With respect, and notwithstanding its grammatical incorrectness, this reasoning is flawed.

Firstly, it is not clear how the Examiner foresees converting Torikai's printer **driver** (which consists of *control information* stored in item 1 of Torikai's memory section 19 in Figs. 1 and 2) into Adobe^{TM}'s PDF format. Moreover, it is not clear what the Examiner expects to achieve by attempting to perform such a conversion, or whether Torikai would consider that a PDF file qualifies as an "update" of a driver. With respect, the Examiner's aforementioned brief statement is unfounded and does not provide an adequate showing of an expectation of success.

Based on the above, it should be apparent that the Examiner has not shown that there is a reasonable expectation of success in combining the reference teachings, and hence the Applicant respectfully requests that the rejection under 35 U.S.C. 103 be withdrawn.
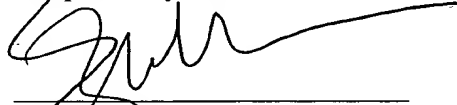
CONCLUSION

In view of the foregoing, the Applicants are of the view that claims 29-48 are in condition for allowance. Favourable reconsideration is requested. Early allowance of the application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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